



UNITED STATES
PATENT AND
TRADEMARK OFFICE

MAY - 1 2003

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

HELLER EHRMAN WHITE & McAULIFFE
4350 LA JOLLA VILLAGE DRIVE, 7TH FLOOR
SAN DIEGO, CA 92122

#19

In re Application of :
Partha S. Banerjee et al :
Serial No.: 09/887,281 : PETITION DECISION
Filed: June 22, 2001 :
Attorney Docket No.: 18025-1013 :

This is a decision on the petition under 37 CFR 1.181, filed March 21, 2003, requesting withdrawal of the finality of an Office action.

BACKGROUND

A review of the pertinent portion of the file history shows that the examiner mailed a first Office action to applicants on May 22, 2002, in which claims 65-67, 71-73 and 92-93 were withdrawn from consideration following a restriction requirement with claims 62-64, 68-70, 74-76 and 90-91 having been canceled; claim 1 was rejected under 35 U.S.C. 102(e), as anticipated by Adjei et al; claims 4-61, 77-79 and 94-99 were rejected under 35 U.S.C. 103(a) as unpatentable over Adjei et al; claims 2 and 3 were objected to.

Applicants replied on August 22, 2002, by amending only claim 8 to correct a typographical error. The rejections of record were addressed and arguments for patentability were set forth.

The examiner mailed a Final Office action to applicants on January 22, 2003. The examiner rejected claims 71-73 under 35 U.S.C. 112, first paragraph, as unsupported by the specification; claims 1, 4-12, 18-21, 27-29, 35-38, 44-49, 54, 57-61, 77-79, 88-89 and 94-99 were rejected under 35 U.S.C. 102(a) as anticipated by Hochrainer et al; claims 13-17, 22-26, 30-34, 39-43, 50-53, 55-56, 58, 65-67, 71-73, 80-87, 92-93 and 97-99 were rejected under 35 U.S.C. 103(a) as unpatentable over Hochrainer et al. Claims 2-3 were again objected to.

Applicants replied with this petition on March 21, 2003. An IDS was filed on January 23, 2003, but has not been considered by the examiner..

DISCUSSION

A review of the summary of the first and Final Office actions above shows that additional claims were considered for the first time in the second Office action Pursuant to a petition decision withdrawing the restriction requirement) and were rejected and that the rejections under 35 U.S.C. 112 and under 35 U.S.C. 102(a) and 35 U.S.C. 103(a) were all based on new considerations or references not previously applied and which were not necessitated by any amendment by applicants. The only amendment applicants made to the claims was to claim 8 to correct an obvious typographical error which did not affect the scope of the claim. The examiner's making of the second action Final was clearly premature.

DECISION

Applicants' petition is **GRANTED**.

The Finality of the last Office action is withdrawn. Applicants remain under obligation to respond to the last Office action under 37 CFR 1.111 within the time limit set therein or as may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll

Director, Technology Center 1600